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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/591,185	06/08/2000	Ronald M. Cook	19079-000310US	2668

7590 05/12/2004

Jeffrey S Mann
Townsend Townsend & Crew LLP
Two Embarcadero Center
8th Floor
San Francisco, CA 94111-3834

EXAMINER

EPPS FORD, JANET L

ART UNIT	PAPER NUMBER
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1635

DATE MAILED: 05/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No. 09/591,185	Applicant(s) COOK, RONALD M.	
	Examiner Janet L. Epps-Ford, Ph.D.	Art Unit 1635	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 32-62 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 32-37, 39-42, 44-50 and 56-62 is/are allowed.
- 6) ☒ Claim(s) 38, 43 and 51-55 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. The rejection of claims 32-49 under 35 U.S.C. 112, first paragraph, is withdrawn in response to Applicant's arguments.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 38, 43, and 51-55 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 38 recites the compound of claim 37 "wherein said modified nucleic acids are peptide nucleic acid." There is lack of antecedent basis for this limitation in the claim, because, claim 37 is limited to natural nucleic acids, not modified nucleic acids.

Claim 43 recites "wherein X and Y are independently attached to members selected from the group consisting of a natural base of said nucleic acid chain, a modified base of said nucleic acid chain, a 3'-hydroxy group of a nucleic acid chain, a 5'-hydroxyl group of said nucleic acid chain, a 2'-hydroxyl group of said nucleic acid chain.." These limitations are vague and indefinite because, according to the structure set forth in claim 32, X and Y are attached to R2 and R3 moieties, respectively. R2 and R3 are defined as linker moieties independently selected from the group consisting of substituted or unsubstituted alkyl and substituted or unsubstituted heteroalkyl. The claim does not recite that R2 and R3 are defined as a natural base of said nucleic acid chain, a modified base of said nucleic acid chain, a 3'-hydroxy group of a nucleic

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acid chain, a 5'-hydroxyl group of said nucleic acid chain, a 2'-hydroxyl group of said nucleic acid chain.

Claim 51 defines R2 as having the formula -O-(R11-PEG-Y3-CHOL)-O-, this definition of R2 is unclear since the formula recited in claim 50 defines R2 in the following manner: Nu1-(R2-CHOL)-O-. If R2 as defined in claim 51 was substituted into the structure of claim 50 this would yield the following structure Nu1-(-O-(R11-PEG-Y3-CHOL)-O)-CHOL)-O-, such a structure is difficult to ascertain, and does not appear to be contemplated in the specification as filed. It is likely that Applicants intended to define R2 as simply being -R11-PEG-Y3-.

Conclusion

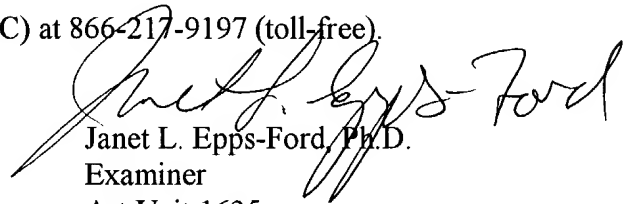
4. Claims 32-62 are free of the prior art searched.
5. Claims 38, 43 and 51-55 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

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6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janet L. Epps-Ford, Ph.D. whose telephone number is 571-272-0757. The examiner can normally be reached on Monday-Saturday, Flex Schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John L. LeGuyader can be reached on 571-272-0760. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Janet L. Epps-Ford, Ph.D.
Examiner
Art Unit 1635

JLE